

Appl. No. 10/789,566  
Amendment dated June 24, 2005  
Reply to Office Action dated June 15, 2005

REMARKS/ARGUMENTS

Claims 1 - 17 are in the application for consideration. Reconsideration of the application is requested.

1. Applicants have amended the specification to update the status of a co-pending application. Also, as requested by the examiner, applicants have corrected a typographical error of which they are aware in the specification.

2. New claims 16 and 17 have been added to the application. These claims are drawn, respectively, to an imaging member and an imaging method wherein the recited compound has a melting point of from about 60°C to about 300°C and are fully supported by the disclosure of the application. See, for example, paragraph [055] at pages 20 and 21.

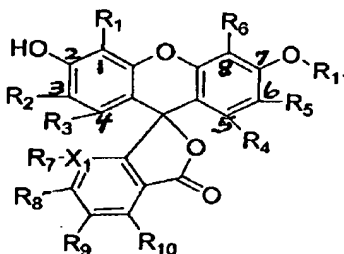
3. Claims 1 - 6 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,278,031 ("Boggs et al."). In support of the rejection the examiner has asserted that the dye in example 15 of the reference meets the structural limitations of the compounds recited in the present claims.

Applicants traverse this ground of rejection. The compounds recited in Boggs et al. in general, and the compound specified in Example 15 in particular, do not teach each and every structural limitation of the compounds of applicants. Referring to claim 1, upon which

Appl. No. 10/789,566  
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claims 2 - 6 are dependent, the claimed compounds of applicants are fluorescein compounds represented by the structural formula I with the recited definitions for the substituents

For the purposes of discussion applicants' generic formula I will be reproduced here with the positions on the central ring moiety numbered to facilitate the discussion of the differences between the compounds of applicants and those of the reference.



In pertinent part, claim 1 recites

provided that at least one of R<sub>1</sub>, R<sub>2</sub>, R<sub>5</sub> and R<sub>6</sub> is selected from the group consisting of alkyl, substituted alkyl, alkenyl, substituted alkenyl, alkynyl, substituted alkynyl, heterocycloalkyl, substituted heterocycloalkyl, aryl, substituted aryl, heteroaryl and substituted heteroaryl.

Appl. No. 10/789,566  
Amendment dated June 24, 2005  
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Thus, applicants' claimed compounds require that there be a substituent selected from the specified list in at least one of the 1, 3, 6 and 8 positions. This feature of applicants' compounds is not taught or suggested by Boggs et al.

Boggs et al. does not teach or suggest any substituent in those positions of the compound shown in Example 15 of the reference. Further, compound V (column 8 lines 15 - 47) of Boggs et al. also only teaches hydrogen in those positions.

Reconsideration of this ground of rejection and withdrawal thereof are respectfully requested.

4. Claims 7 - 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,641,147 ("Sakura et al.") in view of Boggs et al. Sakura et al. has been cited to show a multicolor thermal imaging material comprising three layers carried on a substrate. The examiner has concluded that although Sakura et al. is silent with respect to specific colorants, it would be obvious to one of ordinary skill in the art to use the dyes of Boggs et al. in the thermal imaging method of Sakura et al.

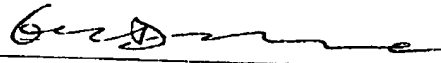
Applicants traverse this ground of rejection. Claims 7 - 15, as well as newly added claims 16 and 17 recite a thermal imaging member and a thermal imaging method utilizing a compound recited in claim 1. As acknowledged by the examiner, Sakura et al. does not teach any specific colorants and it has been shown above that Boggs et al. does not teach or suggest the compounds of applicants.

Appl. No. 10/789,566  
Amendment dated June 24, 2005  
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For these reasons applicants respectfully request reconsideration of this ground of rejection and withdrawal thereof.

In summary the claims are proper in form for allowance and in substance have been shown to be wholly novel and patentably distinguishable over the references of record. Reconsideration of the application and allowance of the claims are respectfully requested.

Respectfully submitted,

  
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